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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,709	08/07/2001	Martin Sielaff	049050-5011	1241

7590

06/15/2005

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EXAMINER

MARTIN, NICHOLAS A

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,709

Applicant(s)

SIELAFF ET AL.

Examiner

Nicholas Martin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-23 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Claims 3-23 are presented for examination. Claims 1-2 and 24 are not elected.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 3-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Beck et al. (hereinafter Beck), US 6,381,640.

4. As per claim 3, Beck teaches computer-readable medium having computer-executable instructions for performing steps comprising:

receiving demographic information (Col. 8, lines 35-53; Col. 15, lines 21-34);

comparing the demographic information received to demographic values stored in one or more rules clauses stored in one or more files stored in a package of files (Col. 15, lines 21-34; Col. 16, lines 51-55);

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selecting files from the package based on the comparison (Col. 16, lines 55-67);  
and

executing actions associated with the selected files (Col. 17, line 8 – Col. 18, line 3).

5. As per claim 4, Beck teaches a data structure for a decision engine stored in a computer readable medium, the data structure comprising:

first section for storing actions to be performed (Col. 9, line 64 – Col. 10, line 3);  
and

second section containing one or more rules clauses to be executed by the decision engine, the execution of the actions in the first section depending on the evaluation of the rules clauses (Col. 17, line 8 – Col. 18, line 3; Col. 20, lines 35-54; Col. 34, lines 10-16; Col. 36, lines 35-39).

6. As per claim 5, Beck teaches the data structure of claim 4 further comprising a third section containing one or more grammar definitions which define comparison statements for the rules clauses (Col. 15, lines 21-34; Col. 16, lines 47-55).

7. As per claim 6, Beck teaches a rules evaluation system for a user's computer comprising:

a rules-based agent having a plurality of rule clauses for evaluating data (Col. 11, line 66 – Col. 12, line 3);

a plurality of triggers having functionality to notify the rules-based agent to begin evaluating (Col. 7, lines 41-58; Col. 9, lines 30-57);

a plurality of data providers to provide data for evaluation (Col. 1, line 63 – Col. 2, line 10, lines 25-34; Col. 35, line 65 – Col. 36, line 12); and

a plurality of actions for providing information to a user based upon the evaluated data (Col. 17, line 8 – Col. 18, line 3).

8. As per claim 7, Beck teaches the rules evaluation system of claim 6, wherein the trigger is based upon user activity (Col. 4, lines 5-9).

9. As per claim 8, Beck teaches the rules evaluation system of claim 6, wherein the trigger is based upon time (Col. 36, lines 35-39).

10. As per claim 9, Beck teaches the rules evaluation system of claim 6, wherein the trigger is based upon computer online activity (Col. 24, lines 23-31).

11. As per claim 10, Beck teaches the rules evaluation system of claim 6, wherein the trigger is based upon hardware present in the computer (Col. 8, lines 54-65; Col. 16, lines 55-61).

12. As per claim 11, Beck teaches the rules evaluation system of claim 6, wherein the trigger is based upon software present in the computer (Col. 3, lines 45-53; Col. 5, lines 21-32; Col. 28, line 62 – Col. 29, line 20).

13. As per claim 12, Beck teaches the rules evaluation system of claim 6, wherein rule clauses can be added dynamically (Abstract; Col. 6, lines 6-10).

14. As per claim 13, Beck teaches the rules evaluation system of claim 6, wherein triggers can be added dynamically (Abstract; Col. 6, lines 6-10).

15. As per claim 14, Beck teaches the rules evaluation system of claim 6, wherein data providers can be added dynamically (Col. 6, lines 6-10; Col. 13, lines 47-52; Col. 50, lines 31-45; Col. 51, lines 51-54).

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16. As per claim 15, Beck teaches the rules evaluation system of claim 6, wherein actions can be added dynamically (Abstract; Col. 32, lines 47-58; Col. 59, lines 16-27).

17. As per claim 16, Beck teaches the rules evaluation system of claim 6, wherein the data provider detects a level of ink in the user's printer (Col. 26, line 65 – Col. 27, line 5).

18. As per claim 17, Beck teaches the rules evaluation system of claim 6, wherein the data provider detects a speed of the user's computer hard drive (Col. 16, lines 55-61).

19. As per claim 18, Beck teaches the rules evaluation system of claim 6, wherein the data provider detects an amount of memory installed on the user's computer (Col. 32, lines 62-67).

20. As per claim 19, Beck teaches the rules evaluation system of claim 6, wherein the data provider detects downloaded software (Col. 17, lines 2-7).

21. As per claim 20, Beck teaches the rules evaluation system of claim 6, wherein the action is a pop-up box displayed to the user (Col. 2, lines 8-10; Col. 35, lines 20-29; Col. 47, lines 52-65).

22. As per claim 21, Beck teaches the rules evaluation system of claim 6, wherein the action is an e-mail sent to the user (Col. 3, lines 1-6; Col. 16, lines 39-50; Col. 17, lines 26-37).

23. As per claim 22, Beck teaches the rules evaluation system of claim 6, wherein the action is a link to a related website presented to the user (Col. 14, lines 47-59; Col. 15, lines 35-42).

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24. As per claim 23, Beck teaches rules evaluation system of claim 6, wherein the action is a video displayed on the user's computer (Col. 1, lines 49-62; Col. 5, lines 43-59).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Rules-Based Decision Engine".

- |      |              |                        |
|------|--------------|------------------------|
| i.   | US 6,317,728 | Kane, Richard L.       |
| ii.  | US 6,298,356 | Jawahar et al.         |
| iii. | US 6,108,686 | Williams, Jr, Henry R. |
| iv.  | US 6,199,099 | Gershman et al.        |

A shortened statutory period for reply to this Office action is set to expire in THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Martin whose telephone number is (571) 272-3970. The examiner can normally be reached on Monday - Friday 8:30 a.m. - 5:30 p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-3970.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Martin  
June 7, 2005

 JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
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